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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
RSW920010113US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number	Filed
	10/706,334	November 12, 2003
on _____	First Named Inventor	
Signature_____	David G. Kuehr-McLaren	
Typed or printed name _____	Art Unit	Examiner
	3621	Augustin, Evens J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
      Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record. Registration number 51,812

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

/Jeffrey T. Holman/
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                   Telephone number

May 24, 2010
                            Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐   *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: David G. Kuehr-McLaren et al.	Group Art Unit: 3621
Application No.: 10/706,334	Examiner: Augustin, Evens J.
Filed: November 12, 2003	Confirmation No.: 6032

For: METHOD, SYSTEM, AND COMPUTER PROGRAM
    PRODUCT FOR DIGITAL VERIFICATION OF
    COLLECTED PRIVACY POLICIES IN ELECTRONIC
    TRANSACTIONS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed February 23, 2010, please find the
following:

Remarks/Arguments begin on page 2 of this paper.

<center>**REMARKS/ARGUMENTS**</center>

This Pre-Appeal Brief outlines the errors in the Examiner's reasoning for the rejections of claims 1-20 of the present application. For reference, claim 5 was objected to, but would be allowable if rewritten in independent form. Claims 1-20 were rejected based on one or more of the following references:

Barzilai et al. (U.S. Pat. Pub. No. 2002/0029201, hereinafter Barzilai)

Bowman-Amuah (U.S. Pat. No. 6,697,824, hereinafter Bowman)

In particular, claims 1-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai in view of Bowman. However, Applicants respectfully submit that these claims are patentable over Barzilai and Bowman for the reasons provided below.

Independent Claim 1

Claim 1 is patentable over the combination of Barzilai and Bowman because the combination of cited references does not teach all of the limitations of the claim. Claim 1 recites:

> A computer-implemented method of conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising the steps of:
> the E-marketplace obtaining, via a computer, <u>digitally-signed privacy-use information</u> for each participant, wherein the digitally-signed privacy-use information is obtained separate from a business transaction between participants; and
> the E-marketplace sharing, via said computer, the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace, wherein the sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace.
> (Emphasis added.)

In contrast, the combination of Barzilai and Bowman does not teach digitally-signed privacy-use information. For reference, the reasoning in the Office Action

acknowledges that Barzilai does not teach digitally-signed privacy information. Office Action, 2/23/10, page 5, paragraph 5. Hence, the reasoning in the Office Action relies on a combination of the privacy information described in Barzilai and the use of digital signatures described in Bowman. However, it should be noted that the combined teachings nevertheless fail to teach digitally-signed privacy-use information because Bowman does not teach using digital signatures for privacy-use information.

Bowman does describe issues surrounding the use of private information. See, Bowman, col. 44, line 46, through col. 48, line 9. Bowman also makes general statements about using digital signatures within an e-Commerce system. See, Bowman, col. 68, lines 6-27. However, these general statements about digital signatures should not be construed as teaching the use of digital signatures for privacy-use information because Bowman does not teach privacy-use information, or rules that establish proscribed uses for the private information. Rather, the digital signatures described in Bowman are specifically used for business transactions, rather than for privacy-use information. For example, Bowman explicitly describes establishing a digital signature strategy for electronic authentication of payments. See, Bowman, col. 62, line 53, through col. 63, line 40 (especially col. 63, lines 36-38). Thus, Bowman merely teaches using digital signatures for the business transactions that occur within the e-Commerce system, not for other communications such as privacy-use rules or information.

Thus, in light of the failure of the references to individually teach digitally-signed privacy-use information, the reasoning in the Office Action relies on the combination of the privacy information described in Barzilai and the digital signatures described in Bowman to assert that it purportedly would have been obvious to implement digitally-signed privacy-use information in an electronic marketplace. However, the proposed combination at best would suggest implementing an e-commerce system that uses privacy information (as described in Barzilai) and <u>separately</u> facilitates digitally-signed business transactions between parties (as described in Bowman). Therefore, the actual teachings of Barzilai and Bowman are insufficient to teach digitally-signed privacy-use information because neither of the cited references describes such information.

Additionally, the assertions in the Office Action are insufficient to support a *prima facie* case of obviousness for the claim. In order to establish a *prima facie*

rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)). The analysis must be made explicit. Id. Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Id.

Thus, there are at least three criteria that must be satisfied in order to establish a *prima facie* case of obviousness:

    1) The rejection must include a conclusion that the claimed invention would have been obvious.

    2) The rejection must include articulated reasoning to support the asserted conclusion of obviousness.

    3) The articulated reasoning must be based on some rational underpinning.

Applicants submit that the general assertions relied on by the Examiner do not provide articulated reasoning with a rational underpinning that is specifically related to the language of the indicated claim. In particular, the general reasoning in the Office Action does not provide an underlying reason why one skilled in the art might endeavor to specifically implement digitally-signed privacy-use information. Rather, the Examiner's reasoning merely asserts that one skilled in the art might implement digital signatures in an electronic marketplace, generally, in order to ensure that the identities of the sender and receiver of information are known. When taken within the context of Barzilai and Bowman, this assertion should be understood specifically with reference to using digital signatures only for the business transactions (e.g., payments) as described in Bowman, but not for any other information such as the privacy information described in Barzilai.

Moreover, to the extent that the Examiner's assertions might apply to language recited in the claims of the present application, it should be noted that the Examiner's assertions are at best derived from impermissible hindsight. Even if the teachings of

Bowman are considered for generally using digital signatures within an electronic marketplace, it appears that the only source of teachings for specifically using digital signatures with privacy-use information is <u>derived from the present application</u>. In other words, it appears that the Examiner attempts to use the reasoning of the present application as the basis for the proposed combination. However, this approach is improper because the reasoning for the proposed combination cannot result from impermissible hindsight based on the teachings of the present application. Accordingly, the reasoning in the Office Action that is presented for support of the rejection of the claims is improper because it is not sufficient to establish a *prima facie* case of obviousness and because it is relies on impermissible hindsight.

CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **09-0461** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **09-0461** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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Date: May 24, 2010

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